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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,677	07/08/2003	Bradley J. Anderson	200300676-1	9829

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,677

Applicant(s)

ANDERSON ET AL.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 13-26, 36-42 and 46-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 27-35 and 43-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Newly submitted claims 46-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Inventions of claims 46-50 and claims 1-12, 27-35 and 43-45 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the particulars of the perforation disposed between the first and second ends to split the wrapper. The subcombination has separate utility such as being used as a package for a tape cassette.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 46-50 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Information Disclosure Statement

2. The Foreign Patent Document No. EP 1 099 639 in information disclosure statement filed 12/3/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 27, 44 and 45 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto (5,137,269). Yamamoto discloses a package (1) comprising a quantity of print medium such as paper (2) and a wrapper (4) having a first end (right side as shown in Figure 1), a second end (left side) and a perforation/separating means (5) disposed between the first and second ends. As to claims 2 and 27, Yamamoto discloses the first end of the wrapper is removed to expose the quantity of print medium.

5. Claims 1, 2, 27, 44 and 45 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura (6,546,210). Nakamura discloses a package (50) comprising a quantity of print medium such as paper (1) and a wrapper (51, 52) having a first end (51), a second end (52) and a perforation/separating means (53) disposed between the first and second ends. As to claims 2 and 27, Nakamura discloses the first end of the wrapper is removed to expose the quantity of print medium (Figures 3-5).

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6. Claims 9-12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (3,302,851). Johnson discloses a wrapper/wrapping means (10, 11, 13, 15, 17, 20-6) for wrapping a book (A) and similar objects/print media comprising a first end, a second end and a perforation (B) disposed between the first and second ends. The perforation comprises a pull-tab (C) is configured to split the wrapper to separate the first and second ends. The book (A) of Johnson is considered equivalent to the print media as broadly claimed because the book can be printed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-8 and 28-35 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (5,137,269) or Nakamura (6,546,210) in view of Honma et al. (5,373,718; hereinafter Honma'718) and Seki (5,510,165). Yamamoto or Nakamura discloses the wrapper as above having all the limitations of the claims except for a pull-tab being configured to split the perforation and the pull-tab comprises a plastic ribbon disposed within the wrapper. Honma'718 shows a package (10) comprising a wrapper (11) including a ribbon (13) disposed within the wrapper for tearing the wrapper and a pull-tab (16) (Figures 3-4). Seki teaches a wrapper (1) for an item (3) comprising a ribbon (2) disposed within the wrapper for tearing the wrapper and a pull-tab (6). Seki further teaches an arrow with the word "OPEN"/label to indicate where to split

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the wrapper. It would have been obvious to one having ordinary skill in the art in view of Honma'718 and Seki to modify the wrapper of Yamamoto or Nakamura so the perforation includes a pull-tab and the pull-tab includes a plastic ribbon disposed within the wrapper to facilitate splitting the wrapper. It also would have been obvious to one having ordinary skill in the art in view of Seki to modify the wrapper of Yamamoto or Nakamura so the placement indicator comprises a label to provide more convenience for the user.

9. Claim 43 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (5,137,269) or Nakamura (6,546,210) in view of Dwyer, Jr. (3,367,487). Yamamoto or Nakamura discloses the wrapper as above having all the limitations of the claims except for the wrapper being made of paper. Dwyer, Jr. discloses a wrapper (30) formed from paperboard. It would have been obvious to one having ordinary skill in the art in view of Dwyer, Jr. to modify the wrapper of Yamamoto or Nakamura so the wrapper is formed from paper to reduce the cost and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

10. Claims 9-12 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Guckenberger (5,630,308) in view of Johnson (3,302,851). Guckenberger discloses in the embodiment of Figures 6 and 7 the package having all the limitations of the claims except for the wrapper being used to wrap print media. Johnson discloses a wrapper/wrapping means (10, 11, 13, 15, 17, 20-6) for wrapping books and similar objects/print media comprising a first end, a

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second end and a perforation/separating means (B) disposed between the first and second ends. The perforation comprises a pull-tab (C) is configured to split the wrapper to separate the first and second ends. It would have been obvious to one having ordinary skill in the art in view of Johnson to modify the package of Guckenberger so the wrapper is used to wrap print media to allow the wrapper of Guckenberger to wrap various items.

Response to Arguments

Applicant's arguments with respect to 12/20/2004 have been considered but are deemed to be moot in view of the new grounds of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Marilyn Watts at (571) 272-4398.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb
February 9, 2005



Luan K. Bui
Primary Examiner